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10/572,753

03/21/2006

Hajime Nakamura

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09/28/2011

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WASHINGTON, DC 20036

EXAMINER

HOBAN, MATTHEW E

ART UNIT

PAPER NUMBER

1734

NOTIFICATION DATE

DELIVERY MODE

09/28/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

## Office Action Summary

Application No.

10/572,753

Applicant(s)

NAKAMURA ET AL.

Examiner

MATTHEW HOBAN

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 11, 19-22 and 26-32 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 11, 19-22 and 26-32 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 32 is objected to because of the following informalities: The claim currently refers to cancelled claim 1. It is thought that this reference and the component R1, it is used to describe can be omitted as claim 11 clearly describes these features. Thus the phrase wherein R1 is as defined in claim 1" can be omitted from the claims to correct this objection. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

1. Claims 11, 19-22, and 26-32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 recites the limitation "another alloy" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is not clear what this recitation refers to in light of the claim as the composition that this alloy refers to is the same as that of Claim 11 and said alloy is used in making the material of claim 1. This can be remedied simply omitting the phrase "of another alloy" or replacing it with a term such as 'compounds'.

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Claim 11 recites the limitation “disposing a powder comprising one or more members selected from an oxide of R2, wherein R2 is one or more elements selected from...”. It is unclear whether the powder is necessitated to comprise other additional elements other than the oxide of R2 or if the presence of R2 alone is sufficient in meeting the claimed limitations. If the use of an oxide of R2 alone is sufficient the phrase “one or more members selected from” should be omitted from the claims. All other claims are dependent therefrom.

***Allowable Subject Matter***

1. Claim 11, 19-22, and 26-32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
2. The following is a statement of reasons for the indication of allowable subject matter: The claimed subject matter is allowable in light of the fact that the powder is disposed on the surface in the form of a slurry prior to sintering. In all of the prior art of reference this step is performed in a powder coating method. The use of a slurry is not necessarily anticipated in light of concerns regarding degradation to the powder and to the material in general. Furthermore, reference to said slurry coating step have been made but applicant has disqualified said art from the record based on the perfection of their foreign priority.

### ***Response to Arguments***

3. Applicant's arguments, see page 4, filed 9/12/2011, with respect to the rejection of the claims under USC 103 have been fully considered and are persuasive. The rejection of the claims over the prior art has been withdrawn. The perfection of the priority document is sufficient in removing the art from the record. As prior art teaching these same teachings relied upon could not be found, no new art rejection is made. However, in light of a proximate allowance of the claims two 112 rejections and an objection have been made.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW HOBAN whose telephone number is (571)270-3585. The examiner can normally be reached on Monday - Friday from 10 AM to 6:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emily M. Le can be reached on 5712720903. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C Melissa Koslow/  
Primary Examiner, Art Unit 1734

/Matthew E Hoban/  
Examiner, Art Unit 1734

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